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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 05/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/875,994

Applicant(s)

BIATRY, BRUNO

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P r i d r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 26-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Amendment filed March 5, 2002. Claims 1-24 and 26-31 are pending. Rejections under 35 U.S.C. § 102 are maintained in part for reasons of record as indicated in the previous office action dated December 5, 2001. New rejections are made in view of the claim amendments by applicants.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-24 and 26-31 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Ribier et al. (U.S. Pat. No. 6,207,694 B1) ("Ribier I").

The rejection is maintained for reasons of record as indicated in the previous office action dated December 5, 2001.

In response to office action dated December 5, 2001, applicants argue that Ribier does not provide any instruction regarding how to use or apply the disclosed composition. Applicants specifically argue that the cited references do not teach or suggest the claimed methods of protecting keratin material from pollution. Examiner respectfully disagrees, as Examples 6 and 7 in the reference are directed to day creams for skin protection. Examiner further notes that the disclosed amount of phytanetriol in Ribier I also meets the "pollution penetration limiting effective amount" of instant claims. Examiner views that the same topically active ingredient used in the same amount must provide the same function. In this case, the claimed method of protecting skin from

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pollution by topically applying the phytanetriol-containing composition is inherently provided by the prior art. Thus, the rejection is proper.

2. Claims 1-3, 5, 6, 15, 17-19, 21, 23-24, 26-28, 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Ribier et al. (U.S. Pat. No. 5,834,018) ("Ribier II").

The rejection is maintained for reasons of record as indicated in the previous office action dated December 5, 2001.

Applicants argue that Ribier II cannot anticipate the claimed methods since it cannot be determined from the disclosure whether the treated skin is actually exposed to pollution. Examiner views that it is irrelevant whether the hydration test has been conducted in the prior art. Disclosed therein is a cosmetic composition containing the claimed amount of the phytanetriol. Application of the cosmetic to the area of skin with either direct or indirect exposure of pollution is anticipated. See also examiner's response in § 102 rejection (1) above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-4, 23-24, 26, 28, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murad (U.S. Pat. No. 6,207,694 B1) in view of Abstract of Japanese Patent 61236737 A (Derwent Acc. No. 1986-321473) ("Kuraray abstract" hereunder).

Murad discloses composition for prevention and treatment of hair and scalp condition comprising phytanetriol. See abstract; Examples 2, 3, 5, and 7-9. The use of the composition encompasses reducing hair and scalp damages from exposure to pollution or overdrying. See instant claims 1, 23, and 24. See col. 5, lines 5 – 12; 9, lines 17 – 21. Examples 2, 3, 5, and 7-9 illustrate formulations comprising phytanetriol in the amount of 0.02 – 0.3 % by weight of the total composition. See instant claims 2 and 3. The formulas are also homogenous mixture of oil and aqueous phases. See instant claims 4, 26, and 29 are met. Examples 5, 7, and 8 are directed to scalp formulation. See instant claims 28 and 31. The reference fails to explicitly teach that phytanetriol used is used as the protective agent.

Kuraray abstract discloses "phytanetriol is known as useful cosmetic component with the protective action for skin or hair." See p. 2, lines 1-2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have expected that the topical application of the phytanetriol-

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containing composition in Murad taught by Murad will provide protective action for scalp and hair from pollution, as taught by Kurary abstract.

2. Claims 1-4, 23, 24, 26, and 29 are rejected under 35 U.S.C. § 103 (a) as unpatentable over Bergmann (U.S. Pat. No. 6,110,450) in view of Kurary abstract.

Bergmann teaches composition for the treatment and protection of hair, comprising glycoceramide and phytanetriol. See abstract. The term "protection" in the reference includes the protection of the hair fibers from the harmful agents from unsuitable hair treatments (and inclement weather). See col. 1, line 17 - 26. Examiner views that applicant's broad definition of pollutant, which include gases or "heavy metals", encompasses the harmful metal agents from the hair treatment products. See spec. p. 2, lines 22-24. Examples 1 and 2 show emulsion formulations comprising phytanetriol in the amount of 0.1 % by weight of the total composition. See instant claims 2-4, 26, and 29. The reference fails to explicitly teach that the phytanetriol is used as the protective agent.

Kurary abstract discloses "phytanetriol is known as useful cosmetic component with the protective action for skin or hair." See p. 2, lines 1-2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have expected that the topical application of the phytanetriol-containing composition in Bergmann will provide protective action for scalp and hair from pollution, as taught by Kurary abstract.

Response to Arguments

Applicant's arguments filed March 5, 2002 have been fully considered but unpersuasive in part, and moot in part in view of the new grounds of rejection.

Applicants' argument regarding claim rejections over Ribier I and Ribier II have been address above Claim Rejection under 35 U.S.C. § 102.

Applicants' argument regarding claim rejections over Murad and Bergmann are moot in view of the new grounds of rejection.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
May 8, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200